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In re Application of
Kinya Hasegawa et al
Application No. 10/721,066
Filed: November 26, 2003
Attorney Docket No. 20402-00639-US1

OFFICE OF PETITIONS

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: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
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This is a decision on the petition under 37 CFR 1.78(a)(3), filed September 13, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications Application No. 09/290,394, filed April 13, 1999, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

The claim for benefit of the prior-filed application cannot be accepted at this time. In this regard, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more **prior-filed** copending nonprovisional applications must contain or be amended to contain a

reference to each such **prior-filed** application, identifying it by application number (consisting of the series code and serial number) **and indicating the relationship of the applications**. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: “This application is a continuation of Application No. 10/—, filed —“ **(inclusion of the title of the invention of each application is not necessary)**. See Manual of Patent Examining Procedure (8th ed., August 2001), Section 201.11, Reference to First Application.

In reviewing the chain of applications to which applicants are seeking to claim priority, it does not appear that petitioner has complied with MPEP Section 201.06(d). The amendment submitted with the instant petition cannot be entered since the relationship of each application to the other is not clearly stated to which priority is being claimed. Therefore, petitioner must review the chain of applications and ensure that compliance with 35 U.S.C. § 120 has been met and, further, must clearly set forth the relationship of each application to the earlier-filed application (i.e., use “which” and “and” to denote the proper relationship between each prior-filed and intermediate application). The amendment as written is unclear as to the relationship of the subject application to the other prior-filed and intermediate applications set forth in the amendment. Petitioner should also note that the prior-filed application must have a filing date earlier than the date of the application claiming the prior-filed application.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a proper amendment¹ along with a renewed petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:

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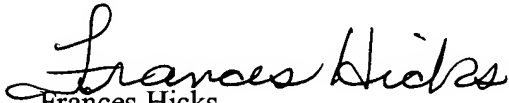
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¹ Note 37 CFR 1.121

As authorized, the \$1,240 fee (1,370 - 130) required by 37 CFR 1.78(a)(3)(ii) will be charged to petitioner's Deposit Account No. 22-0185.

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks
Lead Petitions Examiner
Office of Petitions